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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/015,616 01/29/98 NORVELL

J FA/141A

EXAMINER

IM71/0227

CAROL A LEWIS
W L GORE & ASSOCIATES INC
551 PAPER MILL ROAD
PO BOX 9206
NEWARK DE 19714-9206

TUSKA, C

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

02/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/015,616

Applicant(s)
Norvell et al.

Examiner
Cheryl Juska

Group Art Unit
1771



☒ Responsive to communication(s) filed on Dec 13, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-53 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-53 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on December 13, 2000, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/015,616 is acceptable and a CPA has been established. An action on the CPA follows.
2. **Since Applicant has not responded by arguments or an amendment to the Final Rejection, Paper No. 11, filed on June 16, 2000, the following Office Action is a *repeat* of said Final Rejection.**

Response to Amendment

3. Amendment B, submitted as Paper No. 10 on April 11, 2000, has been entered. The specification has been amended as requested. Claims 1, 3-9, 13-17, 27, 31-38, and 41-44 have been amended. The pending claims are 1-53, with claims 1, 27, 35, 41, 44, and 53 being independent.
4. Amendment B is sufficient to withdraw the objections to the specification, as set forth in sections 1 (a)-(f) and 2 of the last Office Action. Amendment B is also sufficient to withdraw the 35 USC 112, 2nd rejections, as set forth in sections 6-9 of the last Office Action.

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Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claims 28-30, the limitations that the water and wind resistant, breathable material is comprised of polyesters, polyurethanes, polyolefins, copolyetherpolyester, or polyether polyurethane is not supported by the specification. Said objection is maintained from the last Office Action, despite Applicant's traversal. Specifically, Applicant points to page 5, line 36-page 6, line 4 as support for said claim language. The Examiner respectfully disagrees that cited passage is adequate support, in that said recitation merely discloses that the invention includes a water and wind resistant, breathable material. Said recitation does not provide support for the claimed materials. Additionally, Applicant points to working Example 12 as support for claims 28-30. The Examiner agrees that said example teaches a substrate comprising a copolyetherpolyester. However, said example lacks a teaching that said copolyetherpolyester substrate is a water and wind resistant, breathable material and a teaching of the other claimed materials, such as polyolefins, polyurethanes, etc. Therefore, said objection is hereby maintained. To overcome this objection, Applicant may amend the specification to include the claimed subject matter of claims 28-30. Said amendment would not be considered new matter in that claims 28-30 are part of the original disclosure.

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Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 27-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Said rejection is maintained from the last Office Action, section 4. Applicant traverses said rejection by arguing that the invention is not limited to the ePTFE being present as the substrate (i.e., the ePTFE may be present as the flock). The Examiner recognizes this point, but maintains said rejection because the claims do not limit the flock, nor the substrate, to ePTFE. Thus, the claims do not require the presence of ePTFE at all, which is contrary to the disclosure of the present invention.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 53 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,026,591 issued to Henn et al. A discussion of said rejection can be found in the last Office Action, section 11.

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Claim 53 was not amended by Amendment B. It is reasserted that the cited Henn patent inherently meets Applicant's limitation to a flocked article comprising a substrate of ePTFE, wherein at least a portion of said flock is upstanding. By the nature of the flocking process alone, 'at least a portion' of the flock will inherently be upright.

Applicant's traversal of said rejection is found unpersuasive. Specifically, Applicant argues that the Henn invention is differentiated from the present claimed invention in that the flock of the Henn invention does not stand upright (i.e., Henn employs a lesser amount of flock, which is flattened onto the substrate during roll-up of said substrate). Applicant presents samples and micrographs of the cited Henn invention and the present invention as evidence of said arguments. However, as was discussed in the Interview of February 16, 2000, when said samples were originally presented, an Affidavit by Henn or a 132 Declaration needs to be submitted establishing the facts of issue. Specifically, it needs to be established that the submitted sample was made according to Example 8C or 8D of said Henn patent. Additionally, Henn's motivation for flocking the substrate and method of doing so need to be established by Affidavit and/or Declaration, since this information is lacking from the cited patent. Applicant's submission of samples and information on Henn's motivation and method in Amendment B, by the Applicant's representative, is an inadequate showing of evidence required to overcome said Henn rejection.

Additionally, it is asserted even if a Declaration or Affidavit is submitted to establish proper evidence, it will still be argued that at least a portion of the flocked fibers of the Henn

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invention are upstanding. The rejection of claim 53 is an anticipation rejection, and the limitation of issue is deemed inherent to the process of flocking.

In response to Applicant's arguments that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., wear test cycles to leakage) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102/103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-15, 17, 18, 22-26, and 49 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Henn patent. A discussion of said rejection can be found in sections 13 and 14 of the last Office Action.

Said rejection is maintained despite Applicant's amendment and traversal. Specifically, Applicant repeats the above arguments with regard to the submitted examples. However, it is reasserted that the evidence has not been properly submitted.

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Claim Rejections - 35 USC § 103

12. Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Henn patent in view of the cited Lumb patent, as set forth in sections 15 and 17 of the last Office Action.

13. Claims 19, 27, 31-40, 50, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Henn patent, as set forth in sections 16, and 19, 21 of the last Office Action.

14. Claims 21 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Henn patent in view of the cited Wu patent, as set forth in sections 18 and 20 of the last Office Action.

15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Henn patent in view of the cited Gore patent, as set forth in section 22 of the last Office Action.

16. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Henn patent in view of the cited Gore and Aumann patents, as set forth in section 23 of the last Office Action.

17. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Henn patent in view of the cited Ragan patent, as set forth in section 24 of the last Office Action.

18. Claims 44-48 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Henn patent in view of the cited Minor patent, as set forth in section 25 of the last Office Action.

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19. The above 103 rejections are maintained despite Applicant's traversal thereof. Said traversal is limited to the traversal of the primary reference of Henn, as previously discussed above. Thus, for the reasons set forth above, said 103 rejections are also hereby maintained.

Conclusion

20. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached at (703) 308-2414. The official fax number for this TC 1700 is (703) 872-9310 and, for After Final communications, (703) 872-9311.



CHERYL JUSKA
PATENT EXAMINER

February 24, 2001